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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/859,461 | 05/18/2001 | Shinichi Yoshinari | Q64426 | 3963 |

7590

12/23/2002

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EXAMINER

HESS, BRUCE H

ART UNIT

PAPER NUMBER

1774

DATE MAILED: 12/23/2002

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Supplemental Office Action Summary

Application No.

09/859,461

Applicant(s)

Yoshinari et al.

Examiner

Bruce Hess

Group Art Unit

1774

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 10-9-02 (Election)
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-16 is/are pending in the application.
- Of the above claim(s) 9-16 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-8 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☒ Other A copy of Suzuki et al. was not mailed since it was cited by applicants on their PTO-1449.

Office Action Summary

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1. The election requirement of Paper No. 5 is adhered to and made Final for the reasons of record.

~~X~~ Claim 1 is rejected under 35 USC 102(b) as being anticipated by any of the patents to Suzuki et al. (U.S.P. 4,784,905), Kuehrle (U.S.P. 4,792,860) or Hsieh (U.S.P. 5,817,264).

These patents all teach thermal transfer sheets which employ an image information layer which can contain applicants' preferred Permanent Yellow organic pigment.

~~X~~ Claims 1, 4, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the patents to Suzuki et al., Kuehrle or Hsieh.

The experimental modification of the prior art in order to ascertain optimum operating conditions (e.g., determine the pigment/binder ratio and the thickness of the image formation layer) fails to render applicants' claims patentable in the absence of unexpected results.

4. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Yamaguchi et al. (U.S.P. 5,716,477).

Yamaguchi et al. teach that in the art of thermal transfer sheets, the heat resistance of the image formation layer is a result-effective parameter (see column 2, lines 37 and 38). The experimental modification of this prior art in order to ascertain optimum operating conditions (e.g., determine the heat resistance of the image formation layer) fails to render applicants' claims patentable in the absence of unexpected results.

⑤ Claim ~~3~~¹ is rejected under 35 U.S.C. 103(a) as being unpatentable over any of the patents to Suzuki et al., ~~Kuehrle~~ or Hsieh in view of either of applicants' statement of the prior art or the patent to ~~Shinji~~ (Jp 09169165).

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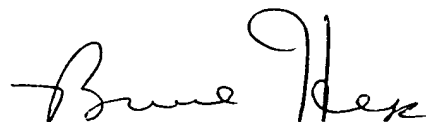
Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the patent to Yamaguchi et al. in view of either applicants' statement of the prior art or the patent to Shinji.

The primary references apply as per the preceding paragraphs. The secondary references teach the advantages (e.g., better and more light-heat conversion layer on thermal transfer sheets. Consequently, use of light-heat conversion layers for their concomitant function on the thermal transfer sheets of the primary references would have been obvious to one of ordinary skill in this art in the absence of unexpected results.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce Hess whose telephone number is (703) 308-2402. The examiner can normally be reached on Monday to Friday 9 Am to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7115 for regular communications and (703) 308-7115 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



B. Hess/mn
ember , 2002

BRUCE H. HESS
PRIMARY EXAMINER